44. A method of making a protein, comprising culturing said cell of Claim 38 in an environment resulting in expressing said protein and recovering said protein.

45. A method of making a duplex nucleic acid comprising contacting said nucleic acid of Claim 39 with a complementary nucleic acid under selective hybridization conditions of at least 45° C and less than 500 mM salt, thereby forming said duplex.

46. A method of making a nucleic acid of Claim 11, comprising amplifying said nucleic acid using PCR amplification methods.--

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REMARKS

Applicants respectfully request examination and consideration of the newly proposed claims in view of the following remarks.

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I. Status of the Application

Applicants had elected the nucleic acid claims pursuant to a traversed Restriction Requirement. Claims 11-17 were in the elected group. The Examiner called and indicated that upon reconsideration, Claims 1-6 would also be examined. No substantive written Office Action has yet been received.

Yesterday, Applicants had transmitted a preliminary amendment which the Examiner has indicated has not yet been entered, and will be considered a "draft". As such, the present preliminary amendment is based upon the originally filed Claims.

II. The Invention

The present application pertains to compositions related to the 499E9 gene, which is related to tumor necrosis factor.

III. The Restriction Requirement

Claims 7-10 and 18-20 are canceled pursuant to a finalized and reconsidered telephone Restriction Requirement. The Examiner indicated that upon reconsideration, Groups I and IV would be examined together. Applicants preserve the right to pursue such subject matter in divisional applications without prejudice.

IV. The Amendments

Please cancel Claim 17.

Claim 1 is amended to incorporate a 100% identity measure and delete the "about". In addition, Applicants amend the language to "polypeptide" and include "contiguous" to remove ambiguity.

New Claim 21 selects one alternative embodiment out of the group in Claim 1.

Claim 2 is amended to incorporate a length of 100% identity over 17 contiguous amino acids. New Claim 22 is directed to 100% identity over the 25 amino acid length from the original Claim 2. New Claim 23 adopts 100% identity over a 30 contiguous amino acid length, which finds support, e.g., from page 14, line 9.

Claim 3 is amended to delete many of the alternative embodiments. Some deleted embodiments are included in new Claims 24 (3/b/v) and 25 (3/b/x-xiii).

Claim 4 is amended to the single "sterile" alternative embodiment. New Claims 26 and 27 are directed to other embodiments from Claim 4.

Claim 5 is rearranged, narrowed, and amended to incorporate reference to SEQ ID NO: 2 and to recite tumor necrosis factor.

Claim 6 is amended to delete the alternative and simplify the language.

Claim 11 is amended to delete many of the alternative embodiments. New Claim 28 incorporates a specific length of nucleotide identity, which finds support, e.g., on page 29, line 9. New Claim 29 is derived from Claim 11 (b/i). Likewise, new Claim 30 incorporates a specific length of nucleotide identity, which finds support, e.g., on page 29, line 10. New Claims 31 and 32 are derived from Claim 11 (b/iii and b/iv), with Claim 32

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incorporating a specific length of nucleotide identity, which finds support, e.g., on page 29, line 10. The full protein coding sequence is indicated in Table 1. Support for the language of "operable linkage" is found, e.g., on page 32, lines 1-18. New Claim 33 incorporates a longer length of identity, which also finds support, e.g., on page 29, line 11. New Claim 34 is derived from Claim 11 (b/vi, b/vii, b/viii, and v/xi). New Claim 35 is derived from Claim 11 (b/xii).

Claim 12 is amended, and Claim 13 is unchanged, but new Claims 36-39 are derived from Claim 12, directed to cells comprising nucleic acid embodiments split away from Claim 11.

Claim 14 now is directed to a kit embodiment containing the remaining nucleic acid of Claim 11. New Claims 40-41 are directed to kits comprising the nucleic acid embodiments split out from Claim 11, e.g., of Claims 34 and 35.

New Claims 42-46 are directed to methods of using or making a composition of seemingly allowable subject matter. This rejoinder of methods is directed to: making a protein by culturing cells of Claims 12, 36, or 38 in an environment resulting in expression of various nucleic acids; making a duplex nucleic acid by allowing hybridization to occur under selective conditions; or making a nucleic acid by PCR amplification methods. Support for expressing nucleic acids is found, e.g., in the section beginning on page 31, describing recombinant expression. Support for making duplex nucleic acids is found, e.g., in the section beginning on page 26, describing hybridization, and generally in the references listed on page 44. Support for PCR methods is found, e.g., on page 27, lines 1-13, or in references listed on page 44.

Certain wording is changed to clarify antecedent basis. The support for the amendments are described, and Applicants believe no new matter is introduced by the amendments. Attached hereto, for the convenience of the Examiner, are the newly proposed claims in Appendix A. Applicants had paid claim fees for 3 independent claims, and 20 total claims. The proposed revised claims number two independent claims and thirty-eight total claims. Applicants authorize charging the DNAX Research Institute Deposit Account 04-1239 for the additional claim fees.

V. SUMMARY

Applicants believe that the present preliminary amendment presents claims which are directed to allowable subject matter. Applicants particularly appreciate the Examiner's assistance and cooperation in making useful suggestions.

CONCLUSION

Applicants believe that all claims now pending in this application are in condition for allowance. Issuance of a formal Notice of Allowance at an early date is respectfully requested. Should this not be appropriate, Applicants respectfully request taht an interview be granted with the undersigned attorney to discuss such issues. The Examiner is invited to telephone the undersigned at (650)496-1204 to arrange for a mutually convenient time and form for the interview.

Dated: December 18, 1998

Respectfully submitted,

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